

SUBJECT: DISCUSSION ON TERMINAL DISCLAIMERS IN INFORMAL FORM

DATE: 1-15-03

APPL. S.N.: 101042815

TO EXAMINER: S. Coe

ART UNIT: 1651

MOSE MONTGOMERY ROOM 11E18

MAILROOM DATE 12-18-02

AFTER FINAL YES ☐ NO ☒ NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

☒ The T.D. is PROPER and has been recorded. (See 14.23).

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

☐ The recording fee of \$ _____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

☐ Application Examiner has not processed T.D. fee. (See fee authorization).

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest... (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

☐ It is directed to a particular claim(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).

☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

☐ Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

☐ Other: _____

☐ Suggestion to request refund of \$ _____. (See 14.35, 14.36).

☐ **EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP**

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).

☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).

☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re the Application of:

ROSE et al.

Serial No.: 10/042,815

Filed: January 8, 2002

Atty. File No.: 4018-1-CON-1

For: "PRODUCT AND METHOD FOR
TREATING JOINT DISORDERS IN
VERTEBRATES"

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

I, Joseph E. Kovarik, represent that I am authorized to execute this Terminal Disclaimer on behalf of In Clover, Inc.; that In Clover, Inc. is a corporation fully organized under the laws of the State of Colorado and has a business address of P.O. Box 11256, Boulder, CO 80301; and that In Clover, Inc. is the owner by assignment of the entire right, title and interest in and to U.S. Patent Application Serial No. 10/042,815, for "PRODUCT AND METHOD FOR TREATING JOINT DISORDERS IN VERTEBRATES", filed January 8, 2002, said assignment being recorded in the U.S. Patent Office at 8617, Frame 0102.

I hereby disclaim, on behalf of In Clover, Inc., the terminal part of any patent granted on U.S. Patent Application Serial No. 10/042,815 which would extend beyond the expiration date of U.S. Patent Nos. 6,344,220 and 5,916,565 and hereby agree on behalf of In Clover, Inc. that any patent granted on U.S. Patent Application Serial No. 10/042,815 shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent Nos.

) Group Art Unit: 1651

) Examiner: S. Coe

)

) TERMINAL DISCLAIMER

)

) "EXPRESS MAIL" MAILING LABEL NUMBER: EL 767794142 US
) DATE OF DEPOSIT: December 18, 2002

)

) I HEREBY CERTIFY THAT THIS PAPER OR FEE IS BEING
) DEPOSITED WITH THE UNITED STATES POSTAL SERVICE "EXPRESS
) MAIL POST OFFICE TO ADDRESSEE" SERVICE UNDER 37 C.F.R.
) 1.10 ON THE DATE INDICATED ABOVE AND IS ADDRESSED TO THE
) ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, D.C.
) 20231.

) TYPED OR PRINTED NAME: Brenda Carpenter

) SIGNATURE: Brenda Carpenter

6,344,220 and 5,916,565, this agreement to run with any patent granted on U.S. Patent Application Serial No. 10 042,815 and to be binding upon the grantee of such patent and its successors or assigns.

I do not disclaim any terminal part of any patent granted on U.S. Patent Application Serial No. 10 042,815 prior to the expiration date of the full statutory term of U.S. Patent Nos. 6,344,220 and 5,916,565 in the event that any such patents later: expire for failure to pay a maintenance fee, are held unenforceable, are found invalid, are statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321(a), has all claims cancelled by reexamination certificate, or are otherwise terminated prior to expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

The evidentiary documents accompanying or referred to in the instant Terminal Disclaimer have been reviewed by the undersigned and it is certified that to the best of assignee's knowledge, title is in the assignee.

A check for the statutory disclaimer fee of \$55.00 as specified under 37 CFR 1.20(d) is enclosed herewith.

By: _____

Joseph E. Kovarik

Date: _____

12/18/02

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